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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number Q77431 | |
| Mail Stop AF Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450 | Application Number | Filed | |
| | 10/664,867 | September 22, 2003 | |
| | First Named Inventor Jean-Michel LAURIOL | | |
| | Art Unit | Examiner | |
| | 2617 | Phuoc Huu DOAN | |
| <p style="text-align: center;">WASHINGTON OFFICE 23373 CUSTOMER NUMBER</p> | | | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal</p> <p>The review is requested for the reasons(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p><input checked="" type="checkbox"/> I am an attorney or agent of record.</p> <p>Registration number <u>56,616</u></p> <p style="text-align: right;"><u>/Nataliya Dvorson/</u> Signature</p> <p style="text-align: right;"><u>Nataliya Dvorson</u> Typed or printed name</p> <p style="text-align: right;"><u>(202) 857-3228</u> Telephone number</p> <p style="text-align: right;"><u>December 3, 2007</u> Date</p> | | | |

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q77431

Jean-Michel LAURIOL

Appln. No.: 10/664,867

Group Art Unit: 2617

Confirmation No.: 4318

Examiner: Phuoc Huu DOAN

Filed: September 22, 2003

For: METHOD AND SYSTEM FOR INFORMING A PERSON THAT A WLAN IS
ACCESSIBLE

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated July 3, 2007, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant turns now to the rejections at issue:

Claims 1-6 and 8-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Gunnarsson in view of U.S. Patent No. 6,959,207 to Keinonen (hereinafter "Keinonen").

Applicant respectfully traverses this rejection in view of the following comments. Independent claims 1, 6, and 8 all include in some variation a mobile data terminal detecting presence of WLAN and informing that access to the WLAN is possible (*i.e.*, that WLAN access is available) by sending a signal from the mobile data terminal to a radiotelephone terminal. The Examiner

appears to take the position that since the mobile data terminal of Gunnarsson accesses a WLAN, it somehow meets the unique features of these independent claims (*see* page 4 of the Office Action).

Applicant respectfully submits that accessing a WLAN by a data terminal, as disclosed in Gunnarsson, does not disclose or suggest the data terminal detecting presence of the WLAN at least because when the data terminal of Gunnarsson attempts to access the WLAN, the presence of the WLAN was already determined and also because connecting to the WLAN involves interchange of messages as opposed to simple detection of the existence of WLAN signals. For example, with respect to the detection of the presence of the WLAN, Gunnarsson discloses that a user location is determined via a mobile terminal 60 (§§ 20 and 22) and the user location is then compared to the known location and extent of WLANs 20, e.g., from a database or other information resource within the communication network 10 (§ 22). In short, Gunnarsson does not disclose or even remotely suggest detecting presence of the WLAN by detecting signals broadcast by the WLAN.

Additionally, the Examiner acknowledges that Gunnarsson does not disclose or suggest informing of access to a WLAN by sending a signal from the mobile data terminal to the radiotelephone terminal. The Examiner, however, contends that Keinonen cures the above-identified deficiencies of Gunnarsson. The Examiner alleges that col. 4, lines 20 to 42 of Keinonen disclose the above-identified unique features of the independent claims. Applicant respectfully disagrees. Keinonen merely discloses that one or both wireless terminals 100, 100 may be linked to receive a notifying message and to notify a person regarding the activation (or manipulation) of a data object (electronic representation) associated with a user (col. 4, lines 29-

35). Nowhere does Keinonen disclose informing that access to WLAN is available. Keinonen merely discloses notifying messages may notify a person of activation of an electronic representation or an emotion associated with the user or (col. 6, lines 10 to 36). In other words, in Keinonen, the data object is an electronically-represented data object, such as received email message, phonebook entry and an avatar that the user associates with a particular person to whom he or she feels an affinity (Fig. 6; col. 1, lines 27 to 34). Keinonen does not disclose or even remotely suggest that the notification informs of an availability of access to the WLAN. In short, Keinonen does not cure the above-identified deficiencies of Gunnarsson and is unrelated to detection and access to the WLAN.

Furthermore, one of ordinary skill in the art would not have and could not have combined the references in the manner suggested by the Examiner. The Examiner contends that one of ordinary skill in the art would have been motivated to incorporate the sending of notifications so that information may be conveyed over a Bluetooth or PWAN link (*see* pages 7-8 of the Office Action). The Examiner merely describes what may occur if Keinonen and Gunnarsson were combined, but fails to address why one skilled in the art would be motivated to combine these references. This reasoning does not provide the necessary motivation. In actuality, even if Gunnarsson and Keinonen in combination disclosed the claimed invention, which they do not, there exists no motivation for one skilled in the art to combine the teachings of Gunnarsson with those of Keinonen. For example, as mentioned above, Gunnarsson discloses determining the position of user such that communication network 10 may notify mobile terminal 60 when mobile terminal 60 is within the coverage area serviced by WLAN 20, or when mobile terminal 60 is approaching such a coverage area. Gunnarsson also discloses that after mobile terminal 60

receives the notification message from the communication network 10, the WLAN interface 72 of the wireless computing device 70 is enabled to establish wireless data communication with the WLAN 20. If the wireless computing device 70 were to notify the mobile terminal 60 that the wireless computing device 70 detects the WLAN 20, it could only do so after the mobile terminal 60 enables the WLAN interface 72 of the wireless computing device 70. Since the mobile terminal 60 has already received a notification from the communication network 10 that informs the user that he or she may access the WLAN 20, there exists no reason to send another redundant notification to the mobile terminal 60 from the wireless computing device 70.

With respect to claim 2, Gunnarsson merely discloses that when the wireless computing device is not in the range of a WLAN, the wireless computing device conserves battery by not scanning for a WLAN (Abstract). In other words, the wireless computing terminal only scans when alerted by the mobile terminal, but otherwise does not perform scanning. When alerted, the wireless computing terminal would scan constantly. The mobile terminal only alerts the wireless computing device due to a presence of a WLAN. The mobile terminal does not alert the wireless computing device periodically. Accordingly, Gunnarsson fails to teach or suggest at least the claimed feature of the mobile data terminal of claim 1 being switched to a mode in which it scans periodically, as recited in claim 2. Furthermore, Keinonen fails to address this deficiency of Gunnarsson.

For at least these exemplary reasons, claims 1, 2, 6, and 8 are patentably distinguishable from Gunnarsson in view of Keinonen. Therefore, Applicant respectfully requests the Pre-Appeal Board to reverse this rejection of claims 1, 6, and 8 and their dependent claims 2-5 and 9-15.

Claim 18 is rejected under 35 U.S.C. § 112, first paragraph. Specifically, the Examiner contends that “the mobile data terminal **is configured to connect to the WLAN...** and wherein the radiotelephone terminal **is not configured to detect the signals broadcasted**” is not described in the specification such as to enable one of ordinary skill in the art (see page 2 of the Office Action). Applicant respectfully disagrees. FIG. 1 of an exemplary embodiment discloses radio access point 5 of WLAN 2 in communication with mobile data terminal 3, the mobile data terminal 3 in turn is in communication with the radiotelephone terminal 4. Accordingly, the mobile data terminal 3, being in communication with the radio access point 5, may be configured to connect to the WLAN access point. The radiotelephone terminal 4 which is not in communication with radio access point 5, may not be configured to detect the signals broadcasted by the WLAN. Thus, the claimed features of the mobile data terminal being configured to connect to the WLAN, and the radiotelephone terminal not being configured to detect the signals broadcasted by the WLAN is supported at least by paragraph 25 and FIG. 1 of the specification. For at least these exemplary reasons, it is appropriate to reverse the rejection.

Respectfully submitted,

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